APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,217	10/28/2003	Ludomir A. Budzyn	B-1	4967

7590   03/14/2007
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EXAMINER
WASSUM, LUKE S

ART UNIT	PAPER NUMBER
2167	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)
Office Action Summary		10/695,217	BUDZYN, LUDOMIR A.
		Examiner	Art Unit
		Luke S. Wassum	2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 January 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 October 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23

January 2007 has been entered.

The Invention

2.   The claimed invention is a method for investigating intellectual property related

to a reference piece of intellectual property. In one embodiment, the user inputs a

trademark, and the system generates a list of patents and patent applications which are

related in some way to said trademark.

Priority

3.   The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon

U.S. Provisional Patent Application 60/421,710, filed 28 October 2002, is acknowledged.

Drawings

4.   The application includes informal (hand drawn) drawings. While these drawings are acceptable for examination purposes, the examiner encourages the Applicant to submit formal drawings at the earliest opportunity. Early submission of formal drawings will help expedite post-allowance processing and publication of the issued patent.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by **Frank et al.** (U.S. Patent Application Publication 2006/0224412).

7.   Regarding claim 1, **Frank et al.** teaches a method for investigating intellectual

property related to a user inputted reference piece of intellectual property (see

disclosure that a user can perform a search for particular products based upon various

criteria, including associated trademark-related IP data records, paragraph [0311]; see

also drawing Figures 78-80) as claimed, said method comprising:

a) providing a first database of discrete pieces of first intellectual property, said

pieces of first intellectual property each including an associated set of first

characteristics (see disclosure that the system includes multiple databases

including various embodiments of intellectual property, such as patents,

trademarks, copyrights and trade secrets, among others, paragraphs [0053]

and [0232] et seq.);

b) providing a second database of discrete pieces of second intellectual property,

said second intellectual property being of a different type from said first

intellectual property (see disclosure that the system includes multiple

databases including various embodiments of intellectual property, such as

patents, trademarks, copyrights and trade secrets, among others,

paragraphs [0053] and [0232] et seq.);

c) searching said first database to identify said pieces of first intellectual property

having predetermined characteristics in common with the reference piece

of intellectual property (see drawing Figure 81, illustrating the submission

of a search request for product information, the predetermined

characteristics being the selected product; see also disclosure that upon

selection of a product, the first [trademark] database is queried to display

any trademarks associated with the selected product, paragraph [0314] and

drawing Figures 82 and 83);

d) developing without user input at least one query based on at least a portion of

said first characteristics of said identified pieces of first intellectual

property (see disclosure that upon selection of a product, the second

[patent] database is queried to display any patents associated with the

selected product, the claimed first characteristics being the selected

product, paragraph [0314] and drawing Figures 82 and 83);

e) searching without user input said second database to identify said pieces of

second intellectual property satisfying said at least one query (see

disclosure that upon selection of a product, the second [patent] database is

queried to display any patents associated with the selected product, the

claimed first characteristics being the selected product, paragraph [0314]

and drawing Figures 82 and 83); and

f) transmitting information related to said identified pieces of second intellectual

property to the user (see drawing Figures 82 and 83, illustrating the display

of information related to said identified pieces of second [patent]

intellectual property to the user).

8.   Regarding claim 2, **Frank et al.** additionally teaches a method for investigating

intellectual property wherein said pieces of first intellectual property are selected from

the group consisting of registered trademarks, unregistered trademarks and

applications to register trademarks (see disclosure that the system includes multiple

databases including various embodiments of intellectual property, such as patents,

trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et

seq.).

9.   Regarding claims 3 and 5, **Frank et al.** additionally teaches a method for

investigating intellectual property wherein said pieces of second intellectual property

are selected from the group consisting of patents and patent applications (see disclosure

that the system includes multiple databases including various embodiments of

intellectual property, such as patents, trademarks, copyrights and trade secrets, among

others, paragraphs [0053] and [0232] et seq.).

10.   Regarding claims 4 and 6, **Frank et al.** additionally teaches a method for

investigating intellectual property wherein the reference piece of intellectual property is

a trademark (see disclosure that the system includes multiple databases including

various embodiments of intellectual property, such as patents, trademarks, copyrights

and trade secrets, among others, paragraphs [0053] and [0232] et seq.).

11.   Regarding claim 7, **Frank et al.** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

are identical matches to the reference piece of intellectual property (see disclosure that a

user can perform a search for particular products based upon various criteria, including

associated trademark-related IP data records, paragraph [0311]; see also drawing

Figures 78-80; see also drawing Figure 81, illustrating the submission of a search request

for product information; see also disclosure that upon selection of a product, the first

[trademark] database is queried to display any trademarks associated with the selected

product, paragraph [0314] and drawing Figures 82 and 83; note that since the product is

associated with the reference piece of intellectual property [trademark], the search of

the first [trademark] database will retrieved the trademark identical to the reference

piece of intellectual property [trademark]).

12.   Regarding claim 8, **Frank et al.** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

include at least one search term in common with at least a portion of the reference piece

of intellectual property (see disclosure that a user can perform a search for particular

products based upon various criteria, including associated trademark-related IP data

records, paragraph [0311]; see also drawing Figures 78-80; see also drawing Figure 81,

illustrating the submission of a search request for product information; see also

disclosure that upon selection of a product, the first [trademark] database is queried to

display any trademarks associated with the selected product, paragraph [0314] and

drawing Figures 82 and 83; note that the search term in common would be the product

associated with all of the retrieved pieces of intellectual property).

13.   Regarding claim 9, **Frank et al.** additionally teaches a method for investigating

intellectual property further comprising sorting said identified pieces of first intellectual

property (see disclosure of the capability of sorting of IP data, paragraphs [0284]-

[0287]).

14.   Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lee** (U.S.

Patent 6,694,331).

15.   Regarding claim 1, **Lee** teaches a method for investigating intellectual property

related to a user inputted reference piece of intellectual property as claimed, said

method comprising:

    a) providing a first database of discrete pieces of first intellectual property, said

        pieces of first intellectual property each including an associated set of first

        characteristics (see disclosure that the system supports the analysis of

        different types of intellectual property information, such as patents,

        trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10,

        lines 34-40; see also col. 11, line 63 through col. 12, line 7);

    b) providing a second database of discrete pieces of second intellectual property,

        said second intellectual property being of a different type from said first

        intellectual property (see disclosure that the system supports the analysis of

different types of intellectual property information, such as patents,

trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10,

lines 34-40; see also col. 11, line 63 through col. 12, line 7);

c) searching said first database to identify said pieces of first intellectual property

having predetermined characteristics in common with the reference piece

of intellectual property (see disclosure of the identification of a 'source

grouping' of intellectual property information, col. 8, lines 17-28; see also

designation of a 'source grouping', col. 10, lines 34-45);

d) developing without user input at least one query based on at least a portion of

said first characteristics of said identified pieces of first intellectual

property (see disclosure of the use of a source grouping to generate a list of

'different elements' found in the source grouping, col. 8, line 56 through col.

9, line 15; see also col. 10, line 61 through col. 11, line 39; see also col. 11,

line 63 through col. 64, line 29);

e) searching without user input said second database to identify said pieces of

second intellectual property satisfying said at least one query (see

disclosure that the created 'field of search' can be used as a search query to

be executed by a local or remote database, col. 12, lines 26-29; see also

disclosure that the invention can be used to variously search and/or

analyze information related to any form of intellectual property, including

patents and trademarks, col. 12, lines 30-42); and

f) transmitting information related to said identified pieces of second intellectual

property to the user (see disclosure that other modules may be included

that, among other things, output the results achieved through operation of

the search server, col. 2, lines 7-11).

16.   Regarding claim 2, **Lee** additionally teaches a method for investigating

intellectual property wherein said pieces of first intellectual property are selected from

the group consisting of registered trademarks, unregistered trademarks and

applications to register trademarks (see disclosure that the invention can be used to

variously search and/or analyze information related to any form of intellectual

property, including patents and trademarks, col. 12, lines 30-42).

17.   Regarding claims 3 and 5, **Lee** additionally teaches a method for investigating

intellectual property wherein said pieces of second intellectual property are selected

from the group consisting of patents and patent applications (see disclosure that the

invention can be used to variously search and/or analyze information related to any

form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

18.   Regarding claims 4 and 6, **Lee** additionally teaches a method for investigating

intellectual property wherein the reference piece of intellectual property is a trademark

(see disclosure of the receipt of input data or signals from the user identifying select

intellectual property to form a 'source grouping' of intellectual property information,

col. 8, lines 17-28; see also the fact that the intellectual property information can include

trademarks, col. 8, lines 11-17).

19.   Regarding claim 7, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

are identical matches to the reference piece of intellectual property (see disclosure that

the select intellectual property information input by the user may be individual

intellectual property identified by native indicia, which would include identifying

trademarks which identically matched an input native indicia, col. 8, lines 30-34).

20.   Regarding claim 8, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

include at least one search term in common with at least a portion of the reference piece

of intellectual property (see disclosure that the select intellectual property information

input by the user may be individual intellectual property identified by native indicia,

which would include identifying trademarks which have, for instance, a common

assignee, col. 8, lines 30-34).

21.   Regarding claim 9, **Lee** additionally teaches a method for investigating

intellectual property further comprising sorting said identified pieces of first intellectual

property (see disclosure of the sorting of search results, col. 4, lines 49-57 et seq.).

22.   Regarding claim 10, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of sorting includes comparing each of said

identified pieces of first intellectual property with the reference piece of intellectual

property to determine degree of similarity therebetween (see disclosure of the sorting of

search results based upon relevancy or weighted relevancy, col. 4, lines 49-57 et seq.).

23.   Regarding claim 11, **Lee** additionally teaches a method for investigating

intellectual property wherein said steps of developing at least one query and searching

said second database are sequentially conducted for each identified piece of first

intellectual property (see disclosure that each piece of intellectual property in the source

grouping is reviewed in order to ascertain different elements to be used as search

criteria, col. 8, lines 56-63; see also col. 10, line 61 through col. 11, line 2; see also col. 11,

line 63 through col. 12, line 7; also note that for at least the cases where none or exactly

one piece of first intellectual property is identified, the execution of said developing

step and searching step is de facto sequential).

24.   Regarding claim 12, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes the name of the

owner of the associated said piece of first intellectual property, and wherein said at least

one query includes a first query, said first query being to identify all pieces of second

intellectual property in which the owner of the respective said identified piece of first

intellectual property has rights (see disclosure that the search engine performs searches

based on input data such as Inventor and Assignee, col. 4, lines 15-29).

25.   Regarding claim 13, **Lee** additionally teaches a method for investigating

intellectual property wherein said first query being to identify all pieces of second

intellectual property in which the owner of the respective said identified piece of

intellectual property has recorder ownership rights (see disclosure that the search

engine performs searches based on input data such as Inventor and Assignee, col. 4,

lines 15-29).

26.   Regarding claim 14, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes the goods or

services of the associated said piece of first intellectual property, and wherein said at

least one query includes a second query, said second query being to identify all said

pieces of second intellectual property which relate to the goods or services of the

respective said identified piece of first intellectual property (see disclosure that the

intellectual property can be searched based on classification, including the classification

of goods and services for trademarks, col. 6, lines 35-56).

27.   Regarding claim 15, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes information

relating to dates of first use of the associated said piece of first intellectual property, and

wherein said at least one query includes a third query, said third query being to identify

all said pieces of second intellectual property having a filing date or priority date after

the dates of first use of the respective said identified piece of first intellectual property

(see disclosure that the search engine performs searches based on input data such as

Publication Date, Filing Date, Related Data and Priority Data, col. 4, lines 15-29).

28.   Regarding claim 16, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes a classification of

the associated said piece of first intellectual property, and wherein said at least one

query includes a fourth query, said fourth query being to identify all said pieces of

second intellectual property having a classification equivalent to the classification of the

respective said identified piece of first intellectual property (see disclosure that the

search engine performs searches based on input data such as International

Classification, U.S. Classification, and Cross-Reference Classification, col. 4, lines 15-29).

Response to Arguments

29.   Applicant's arguments filed 23 January 2007 have been fully considered but they

are not persuasive.

30.   Regarding the Applicant's argument that the **Lee** reference fails to disclose the

claimed feature of developing and executing *without user interaction* a query based upon

at least a portion of said first characteristics of said identified pieces of intellectual

property, the examiner respectfully disagrees.

The examiner points out that it is a well settled rule that a reference must be

considered not only for what it expressly teaches, but also for what it fairly suggests.

See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d

747, 192 USPQ 278 (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA

1977) which indicates such fair suggestions to unpreferred embodiments must be

considered even if they were not illustrated. Additionally, it is an equally well settled

rule that what a reference can be said to fairly suggest relates to the concepts fairly

contained therein, and is not limited by the specific structure chosen to illustrate such

concepts. See *In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956).

In this case, the **Lee** reference teaches the use of a field-of-search module

whereby the results of a previous search can be used to "automatically (or manually)

create, add or suggest such search information (e.g., classes and subclasses) for a field-

of-search." See col. 11, lines 37-39.

In this case, the resulting 'field-of-search' constitutes the claimed 'query'. Clearly,

this disclosure anticipates *at least* the claimed development of a query without user

interaction.

Furthermore, at col. 12, lines 19-29, the following is disclosed:

> creation of a field-of-search (step **708**). Where desired, the
> 20 search information may be statistically analyzed for use in
> automatically generating, adding, or suggesting a field-of-
> search. As illustrated in FIG. **5**, for example, search infor-
> mation that has a frequency of appearance in the selected
> source grouping that is greater than a predetermined fre-
> 25 quency value may be automatically added to the field-of-
> search created (step **709**). As used in a search system, as one
> example, the field-of-search thus created can form (or be
> part of) a search query or criteria to be executed by a local
> or remote database.

It is disclosed that the search information is statistically analyzed, and any search

information that has a frequency of appearance greater than a predetermined frequency

may be automatically added to the field-of-search created. Once again, this disclosure

anticipates *at least* the claimed development of a query without user interaction.

However, this disclosure also anticipates the claimed *execution* of a query

without user interaction.

The disclosure differentiates between automatically generating, adding, or suggesting a field-of-search. Clearly, 'suggesting' a field-of-search would require user interaction to confirm or modify the suggestion. However, the reference also discloses, separately from suggesting a field-of-search, generating or adding a field-of-search. Since this is differentiated from the disclosed 'suggesting' a field-of-search, there is a clear suggestion that the 'generated' or 'added' field-of-search is not presented to the user to await some user action.

Furthermore, it is also disclosed that "...the field-of-search thus created can form (or be part of) a search query or criteria to be executed by a local or remote database." This disclosure also clearly suggests that the field-of-search is automatically generated *and thereafter executed* without user interaction.

The rejection is maintained.

Conclusion

31.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Unger et al. (U.S. Patent 5,721,910) teaches a relational database system which can be used to determine the meaning of technical documents such as patents.

Winer et al. (U.S. Patent 6,665,670) teaches a method for determining the likely uniqueness and novelty of a subject concept, such as a patent.

Frank et al. (U.S. Patent 7,127,405) teaches a method for selecting and protecting intellectual property assets.

Lee (U.S. Patent Application Publication 2002/0138297) teaches an apparatus for analyzing intellectual property information.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Luke S. Wassum whose telephone number is 571-272-

4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the

examiner at 571-273-4119. <u>Such communications must be clearly marked as</u>

<u>INFORMAL, DRAFT or UNOFFICIAL.</u>

Customer Service for Tech Center 2100 can be reached during regular business

hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
13 March 2007